

FAXED

Atty Docket No. 084633-000100US

PTO FAX NO.: (703) 872-9307

ATTENTION: Examiner Jon D. Epperson
TELEPHONE NO.: (703) 308-2423

Group Art Unit 1639

**OFFICIAL COMMUNICATION
FOR THE PERSONAL ATTENTION OF**

EXAMINER Jon D. Epperson

CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that the following document(s) in re Application of Jane Osbourn, et al., Application No. 09/817,661, filed March 26, 2001 for RIBOSOME DISPLAY are being facsimile transmitted to the Patent and Trademark Office on the date shown below.

Document(s) Attached

1. Transmittal Form;
2. Petition under 37 CFR §1.181(a) to Withdraw Holding of Abandonment;
3. Notice of Abandonment (copy);
4. Response to Restriction Requirement and Petition for Extension of Time, as filed on 06-25-03; and
5. Return Receipt Postcard (copy), to show Response to Restriction Requirement received by PTO on 06-30-03.

Number of pages being transmitted, including this page: 18

Dated: October 10, 2003

Steven W. Parmelee

Steven W. Parmelee
Reg. No. 31,990

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TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, 8th Floor
San Francisco, CA 94111-3834
Telephone: 206-467-9600; Fax: 206-623-6793
60051679 v1

EXHIBIT

A

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM <i>(to be used for all correspondence after initial filing)</i>		Application Number	09/817,661
		Filing Date	March 26, 2001
		First Named Inventor	Jane Osbourn
		Art Unit	1653
		Examiner Name	Jon D. Epperson
Total Number of Pages in This Submission	1	Attorney Docket Number	084633-000100US ^a

ENCLOSURES (Check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s)	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Petition to Withdraw Holding of Abandonment; Notice of Abandonment (copy); Response to Restriction Requirement and Petition for Extension of Time (copy); Return Receipt Postcard (copy)
Remarks		The Commissioner is authorized to charge any additional fees to Deposit Account 20-1430.

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual	Townsend and Townsend and Crew LLP Steven W. Parmelee Reg. No. 31,990
Signature	<i>Steven W. Parmelee</i>
Date	October 10, 2003

CERTIFICATE OF TRANSMISSION/MAILING			
I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, ATTN: Examiner Jon D. Epperson, P.O. Box 1450, Alexandria, VA 22313-1450 at facsimile no.: (703) 872-9307 on the date shown below.			
Typed or printed name	Jennifer M. Smolen	Date	October 10, 2003
Signature	<i>JM Smolen</i>		

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS.

SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 (1-800-786-9199) and select opt. 2.

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to: Commissioner for Patents, ATTN: Examiner Jon D. Epperson, P.O.
Box 1450, Alexandria, VA 22313-1450 at facsimile no.: (703) 872-9307
On Oct. 10, 2003
By: [Signature]

PATENT
Attorney Docket No.: 084633-000100US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of:
JANE OSBOURN et al.
Application No.: 09/817,661
Filed: March 26, 2001
For: RIBOSOME DISPLAY

Examiner: Jon D. Epperson
Art Unit: 1639

PETITION UNDER 37 CFR § 1.181(a)
TO WITHDRAW HOLDING OF
ABANDONMENT

Commissioner for Patents
ATTN: Examiner Jon D. Epperson
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

In response to the Notice of Abandonment mailed September 23, 2003, Applicants respectfully submit this petition under 37 CFR § 1.181(a) to withdraw the holding of abandonment in this case. Applicants believe that the Notice of Abandonment was issued in error.

The Notice of Abandonment states, "Applicant's failure to timely file a proper reply to the Office letter mailed on 25 February 2003" as the reason for the issuance of the Notice of Abandonment. (A copy of the Notice of Abandonment is attached.) The statutory response period to respond to the Restriction Requirement was extendable from March 25, 2003 to August 25, 2003, with extensions of time. A Response to Restriction Requirement, and a request for a three month extension of time, were timely filed in response to that Restriction Requirement; the Response to Restriction Requirement was deposited as U.S. first class mail, addressed to the U.S. Patent and Trademark Office, on June 25, 2003.

Applicants understand that the Response to Restriction Requirement may not have been received by the Examiner prior to the issuance of the Notice of Abandonment on September 23, 2003. However, Applicants have attached hereto the stamped, return receipt postcard confirming that the Response to Restriction Requirement was delivered to the U.S. Patent and Trademark Office on June 30, 2003. Also enclosed is a "courtesy copy" of the Response to Restriction Requirement, Petition for Extension of Time, and Transmittal, filed on June 25, 2003.

No fee is believed due. However, if deemed necessary, please charge and credit any fees associated with this submission to Deposit Account No. 20-1430.

CONCLUSION

In view of the foregoing, Applicants believe the Notice of Abandonment was issued in error and should be withdrawn. If for any reason further information is required, please contact the undersigned at (206) 467-9600.

Respectfully submitted,

Dated: October 10, 2003

By: Steven W. Parmelee
Steven W. Parmelee
Reg. No. 31.990

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, 8th Floor
San Francisco, CA 94111
(206) 467-9600
60050701 v1



UNITED STATES PATENT AND TRADEMARK OFFICE

084633-000100US SW

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United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,661	03/26/2001	Jane Osbourn	84633-000100US	9792

20350 7590 09/23/2003

TOWNSEND AND TOWNSEND AND CREW, LLP
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EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

EPPELSON, JON D

ART UNIT PAPER NUMBER

1639

DATE MAILED: 09/23/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

NOT ABANDONED
IN DOCKET

Notice of Abandonment

Applicant *Gay*

Application No.

09/817,661

Examiner

Jon D Epperson

Applicant(s)

OSBOURN ET AL.

Art Unit

1639

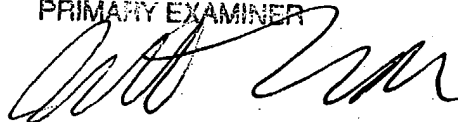
-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

This application is abandoned in view of:

1. ☒ Applicant's failure to timely file a proper reply to the Office letter mailed on 25 February 2003.
 - (a) ☐ A reply was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply (including a total extension of time of _____ month(s)) which expired on _____.
 - (b) ☐ A proposed reply was received on _____, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection.
(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
 - (c) ☐ A reply was received on _____ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
 - (d) ☒ No reply has been received.
2. ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
 - (a) ☐ The issue fee and publication fee, if applicable, was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
 - (b) ☐ The submitted fee of \$_____ is insufficient. A balance of \$_____ is due.
The issue fee required by 37 CFR 1.18 is \$_____. The publication fee, if required by 37 CFR 1.18(d), is \$_____.
 - (c) ☐ The issue fee and publication fee, if applicable, has not been received.
3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
 - (a) ☐ Proposed corrected drawings were received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply.
 - (b) ☐ No corrected drawings have been received.
4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
6. ☐ The decision by the Board of Patent Appeals and Interference rendered on _____ and because the period for seeking court review of the decision has expired and there are no allowed claims.
7. ☒ The reason(s) below:

Please see attached interview summary

BENNETT CELSA
PRIMARY EXAMINER



Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.

Interview Summary

Application No.

09/817,661

Applicant(s)

OSBOURN ET AL.

Examiner

Jon D Epperson

Art Unit

1639

All participants (applicant, applicant's representative, PTO personnel):

(1) Jon D Epperson.

(3) _____

(2) Steven Parmelee.

(4) _____

Date of Interview: 10 September 2003.

Type: a) ☒ Telephonic b) ☐ Video Conference
c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No.
If Yes, brief description: _____

Claim(s) discussed: NONE.

Identification of prior art discussed: NONE.

Agreement with respect to the claims f) ☐ was reached. g) ☐ was not reached. h) ☒ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: The Examiner informed Steven Parmelee that no response had been filed to the February 25, 2003 and, as a result, the case was abandoned.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)


THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.


Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

Examiner's signature, if required

TRANSMITTAL FORM (to be used for all correspondence after initial filing)		Application Number	09/817,661
		Filing Date	March 26, 2001
		First Named Inventor	Jane Osbourn
		Art Unit	1653.
		Examiner Name	Unassigned
Total Number of Pages in This Submission	1	Attorney Docket Number	084633-000100US

ENCLOSURES (Check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input checked="" type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s)	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Response to Restriction Requirement; Return Postcard
Remarks		The Commissioner is authorized to charge any additional fees to Deposit Account 20-1430.

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT		
Firm or Individual	Townsend and Townsend and Crew LLP Mark G. Sandbaken, Ph.D.	Reg. No. 39,354
Signature		
Date	June 25, 2003	

CERTIFICATE OF TRANSMISSION/MAILING			
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Typed or printed name	Mark G. Sandbaken, Ph.D.		
Signature		Date	June 25, 2003

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2.

PETITION FOR EXTENSION OF TIME UNDER 37 CFR 1.136(a)

Bucket Number (Optional)
084633-000100US

In re Application of Jane Osbourn et al.

Application Number 09/817,661

Filed March 26, 2001

For RIBOSOME DISPLAY

Group Art Unit
1653Examiner
Unassigned

This is a request under the provisions of 37 CFR 1.136(a) to extend the period for filing a reply in the above identified application.

The requested extension and appropriate non-small-entity fee are as follows (check time period desired):

- ☐ One month (37 CFR 1.17(a)(1)) \$
- ☐ Two months (37 CFR 1.17(a)(2)) \$
- ☒ Three months (37 CFR 1.17(a)(3)) \$930
- ☐ Four months (37 CFR 1.17(a)(4)) \$
- ☐ Five months (37 CFR 1.17(a)(5)) \$
- ☐ Applicant claims small entity status. See 37 CFR 1.27. Therefore, the fee amount shown above is reduced by one-half, and the resulting fee is: \$.
- ☐ A check in the amount of the fee is enclosed.
- ☐ Payment by credit card. Form PTO-2038 is attached.
- ☐ The Commissioner has already been authorized to charge fees in this application to a Deposit Account.
- ☒ The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account Number 20-1430.
- I have enclosed a duplicate copy of this sheet.

I am the ☐ applicant/inventor.

☐ assignee of record of the entire interest. See 37 CFR 3.71
Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96).

☒ attorney or agent of record.

☐ attorney or agent under 37 CFR 1.34(a).

Registration number if acting under 37 CFR 1.34(a). _____

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

June 25, 2003

Date

Mark G. Sandbaken

Signature

Mark G. Sandbaken, Ph.D. Reg. No.
39,354

Typed or printed name

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

Burden Hour Statement: This form is estimated to take 0.1 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

SE 5017174 v1

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By: M. D. Smith

PATENT
Attorney Docket No. 84633-000100

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of:

JANE OSBOURN et al.

Application No.: 09/817,661

Filed: March 26, 2001

For: RIBOSOME DISPLAY

Examiner: Unassigned

Art Unit: 1653

**RESPONSE TO RESTRICTION
REQUIREMENT**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This communication is submitted in response to the Restriction Requirement dated February 25, 2003, which set forth the following groups of claims:

- I. Claims 1-14 and 21-23, characterized as drawn to a method for "obtaining a specific binding pair (sbp) that binds a complementary sbp member of interest;"
- II. Claims 15-20 and 24, characterized as drawn to a method for "formulating the product into a composition comprising at least one additional component [e.g., excipient or carrier];"
- III. Claims 25-26, characterized as drawn to a product described as a "nucleic acid construct" or a "library or population of RNA molecules;"
- IV. Claims 27-28, characterized as drawn to a product described as a "population of viral particles;" and

- V. Claims 29-30, characterized as drawn to a product described as an "expression system."

Applicants elect to prosecute Group I, claims 1-14 and 21-23, with traverse. Applicants reserve the right to file one or more divisional or related applications to the claims of non-elected groups.

Applicants further elect the following species, each and every one with traverse, in each of Subgroups 1-10, as set forth in Office Action:

Subgroup 1: Applicants elect antibody molecules.

Subgroup 2: Applicants elect an mRNA not containing a midvariant (MDV) RNA, not containing a glycine-serine tether and containing a TMV encapsidation sequence. Applicants direct the Examiner's attention to oligonucleotide primers at pages 32-33 (HA-OAS-1 and -2).

Subgroup 3: Applicants elect the TMV coat protein.

Subgroup 4: Replication is not a claimed method step, but, with traverse, Applicants elect RT-PCR.

Subgroup 5: Applicants elect RT-PCR, with traverse. The requirement is not understood.

Subgroup 6: Applicants elect prokaryotic ribosomes.

Subgroup 7: Applicants elect glutathione not added.

Subgroup 8: Applicants elect disulphide isomerase added.

Subgroup 9: Applicants elect heparin added.

Subgroup 10: Applicants elect the use of mutagenic oligonucleotides and PCR.

Applicants believe that claims 1, 8-14 and 21-23 read on the elected Group I and elected species therein.

REMARKS

The Examiner has required restriction to one of five inventions characterized as follows:

- I. Claims 1-14 and 21-23, characterized as drawn to a method for "obtaining a specific binding pair (sbp) that binds a complementary sbp member of interest;"
- II. Claims 15-20 and 24, characterized as drawn to a method for "formulating the product into a composition comprising at least one additional component [e.g., excipient or carrier];"
- III. Claims 25-26, characterized as drawn to a product described as a "nucleic acid construct" or a "library or population of RNA molecules;"
- IV. Claims 27-28, characterized as drawn to a product described as a "population of viral particles;" and
- V. Claims 29-30, characterized as drawn to a product described as an "expression system."

It is the contention of the Examiner that the five inventions are separate and distinct because the claims in Groups I and II are related as different methods and Groups III-IV are related as different products and which are directed to different purposes, use different materials recite different method or process steps for the preparation of different product(s), screening of different characteristics, such as different binding affinities, different biochemical reaction conditions, etc., or lead to different final results.

Applicants have, as set forth above, elected with traverse to prosecute the claims of Group I, claims 1-14 and 21-23, characterized as drawn to a method for "obtaining a specific binding pair (sbp) that binds a complementary sbp member of interest."

Applicants traverse this restriction requirement and respectfully request the Examiner reconsider the restriction requirement to achieve a proper, compact and expedited prosecution of the present invention.

Restriction can be required by the Office for certain reasons as set forth in the MPEP under section 800. Restriction is required so that an undue burden is not placed on the Office in prosecuting the application, so that the statutory fee structure is not subverted, and so that the integrity of the examination and classification system of the Office are not jeopardized. Requirement for restriction is balanced against the right of the Applicants to claim their

invention as they require to adequately protect their invention and to provide for a compact and expedited prosecution.

Applicants respectfully submit that the presently claimed invention relates to methods and products which together comprise a single invention. Under 35 U.S.C. § 121, there are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (1) the inventions must be independent or distinct as claimed; and
- (2) there must be a serious burden on the examiner if restriction is not required.

See MPEP § 803. Neither of these criteria is met by the presently claimed invention which relates to the single invention of methods of obtaining specific binding pair (sbp) members that bind complementary sbp members of interest and to related nucleic acid constructs, libraries, populations of viral particles and expression systems. All of claims 1 to 24 fully incorporate claim 1, so that a complete search of claim 1 will as a necessity encompass fully the subject-matter of all of claims 1 to 24. Furthermore, all of claims 25 to 30 fully incorporate claim 25, so that a complete search of claim 25 will as a necessity encompass fully the subject-matter of all of claims 25 to 30. Claims 1 and 25 contain corresponding technical features.

A thorough search of the patent or scientific literature directed to such methods and to uses thereof would encompass art in the field of the invention as claimed. For example, a thorough search encompassing the claims of Group I would encompass art in the field of Group II, all of which claims depend from claim 1. Further, Applicants believe a thorough search encompassing the claims of Group I would encompass art in the field of Groups III-IV. Thus, prosecution of the invention, as a whole, would not place a burden on the Examiner sufficient to justify restriction.

Therefore, Applicants respectfully request that the Examiner reconsider the restriction requirement in light of office practices common to the art. In particular, Applicants request that at least the claims of Groups I and II be combined for prosecution on the merits.

Applicants further traverse the requirement that Applicants elect 10 different species within Group I. The Examiner alleges that the species within each Subgroup set forth in the Office Action are patentability distinct from each other.

Applicants have provisionally elected, with traverse, species within the Subgroups, as set forth above. Applicants understand that even if the election of species requirement is maintained then once a generic claim is found to be allowable, additional species will be rejoined by the Examiner to preserve Applicants' right to claim their invention as they require to adequately protect their invention and to provide for a compact and expedited prosecution. See MPEP § 809.02.

However, Applicants traverse the requirement for species elections because the Examiner's designation of species within each Subgroup does not appear to comport with proper restriction practice. In particular, the designation of species is complex and does not appear to be organized along a particular search strategy. Instead, the Examiner appears to have designated all possible species, breaking the invention into a large number of incoherent pieces.

The presently claimed invention relates to an improvement in ribosome display, *i.e.*, a new and non-obvious modification to that technology. Ribosome display technology itself is not new technology; indeed it is practiced commercially and is of great use, as it has been for some time. The modification provided by the present invention does not suddenly remove the usefulness of the technology in its existing various ways, for example in allowing different kinds of specific binding members to be employed, any type of antibody fragment and so on. For the Examiner to require election of species among features that are not relevant for patentability and from which a person of ordinary skill can select as of choice is to provide an undue burden on the Applicants, and indeed on the Examiner. Rather, there is no burden in searching across the breadth of the various species that the Examiner seeks election between.

Another example of where no feature of patentability resides is in the choice of downstream expression system for production of the specific binding member following the ribosome display steps (*e.g.*, claim 22). The skilled person is well able currently to choose between a large variety of host cells for this purpose (proteins have been expressed recombinantly in countless different host cells), and there is no inventive feature in the choice. The Examiner in seeking to divide a straightforward biotechnological invention into multiple species and sub-species is creating the potential for a multiplication of cost and complexity of

searching where in fact a single search relating to the features that actually make up the contribution provided by the invention will be fully adequate.

In cases where an election of species requirement is proper then the Examiner should group together species considered clearly unpatentable over each other, and also identify species that are considered patentably distinct from each other. MPEP § 808.01(a). The Examiner has not done such an analysis. Instead, the Examiner appears to have designated all identified species as patentably distinct and placed the burden on Applicants to demonstrate otherwise. This is, respectfully, an improper shifting of the burden to the Applicants and is not consistent with proper restriction practice.

The designation of species also does not appear to be proper because the designated species do not appear to be restricted to those with mutually exclusive characteristics. See MPEP § 806.04(f) ("The general test as to when claims are restricted, respectively, to different species is the fact that one claim recites limitations which under the disclosure are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not the first.") and MPEP § 808.01(a).

As noted, there are species of Group I that are not mutually exclusive. For example, in Subgroup 1, the Examiner has required election of a single species of specific binding pair member, citing page 19, line 5 of the specification. The Examiner suggested scFv antibody molecules. The Examiner appears to be taking the position that scFv antibody molecules are patentably distinct from the other recited antibody molecules. The invention is useful with any specific binding member. The Applicants have elected with traverse, antibody molecules, a species of specific binding member. If the Office regards this as an insufficient election (although the Applicant believes the requirement should in fact be withdrawn entirely), then the Applicant elects, with traverse, scFv antibody molecules.

Similarly, for Subgroups 7, 8 and 9, the Examiner appears to believe the species within these Subgroups are patentably distinct, but the Examiner has not provided any reasoning to support the assertion that these species are patentably distinct.

Further, the totality of species designated in Group I are not mutually exclusive. The Examiner has designated 10 different "Subgroups" of species. Applicants do not understand the

rational for such identification of Subgroups because the Subgroups do not appear to be mutually exclusive of each other. Moreover, a proper search will encompass multiple species and sub-species and the Office does not appear to have identified a search strategy that would require including within the search particular stated "species" and "subspecies" while excluding from the search other stated "species" and "subspecies." The Applicants respectfully believe that a search of claim 1 will also include a search of the subject-matter of the dependent claims.

Thus, Applicants respectfully request that if the species election requirement is not withdrawn, then at least the Examiner reformulate the election of species to correspond to the intended search parameters so the Applicant can understand what the Examiner seeks to achieve and can make proper species requirements in response to a proper requirement.

As set forth above, Applicants further request that Group II be rejoined with Group I. If these Groups are rejoined, Applicants elect the species set forth above for Subgroups 1-9. Applicants further make the following elections, with traverse, as required for Subgroups 10-12 of Group II:

Subgroup 10: Applicants elect a pharmaceutically acceptable excipient (although ordinary skilled persons can readily add any component to a composition).

Subgroup 11: Applicants elect an antibody constant region (although ordinary skilled persons have been able to make fusion proteins of countless variety for many years).

Subgroup 12: Applicants elect a bacterial expression system (although eukaryotic *e.g.*, mammalian expression systems, have long been at the disposal of the ordinary skilled person).

If Groups I and II are rejoined, then additional claims 15-20 and 24 will read on the elected Groups and species within those Subgroups.

Thus, Applicants respectfully request that the Examiner reconsider the necessity for a restriction requirement in this case. In addition, without acquiescing to the propriety of the restriction requirement, Applicants respectfully request reformation of the species designation to include all the species identified by the Examiner, or at least to conform to some reasonable number of clearly identified and properly reasoned mutually exclusive species within Groups I and II.

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If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 206-467-9600.

Respectfully submitted,

Dated: June 25, 2003

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RE: Jane Osbourn et al.

TITLE OF DOCUMENT(S):

- Transmittal
- Pet. for Ext. of Time (3 mos.)
- Response to Restriction Requirement

Application No. 09/817,661

File No. 84633-000100US

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